

In re Application of: Ehud GAZIT
Serial No.: 10/562,852
Filed: April 19, 2006
Office Action Mailing Date: December 16, 2008

Examiner: DUTT, Aditi
Group Art Unit: 1649
Attorney Docket: 31230

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1, 12, 40, 72-79, 81-102, 118, 141, 148 and 155-159 are in this Application. Claims 40, 73, 75, 76, 82-94, 96, 98-102, 141, 148 and 155-159 have been withdrawn from consideration. Claims 1, 12, 72, 74, 77-79, 81 and 95 have been rejected under 35 U.S.C. § 101. . Claims 1, 12, 72, 74, 77-79, 81 and 95 have been rejected under 35 U.S.C. § 112-second paragraph. Claims 72, 74, 77-79, 81 and 95 and 97 have been rejected under 35 U.S.C. § 112-first paragraph. Claims 1, 72, 74 and 77-79 have been rejected under 35 U.S.C. § 102. Claims 74, 97, 98 have been canceled herewith. Claims 1, 12, 72, 77, 81, 95 have been amended herewith. New claim 163 has been added herewith.

Amendments To The Specification

The Examiner has objected to the disclosure because the application fails to comply with the requirements of 37 CFR 1.821 through 1.825. Accordingly Applicant has amended the sequences in Figures 1, 3a, 3c, 8a, 8b, 10b, 11, 16a, 16b, 19a, 20a, 23, 42c, 46a, 46b to include relevant sequence identifiers.

The Examiner objected to the disclosure for including an embedded hyperlink. Applicant has amended the specification to remove the hyperlink.

The Examiner has objected to the disclosure since the brief description of the drawings lacks sequence identifiers. The specification has been amended accordingly.

The Examiner has objected to the description of Figure 39 for lacking sequence identifiers for the 5th peptide. The specification has been amended accordingly.

The Examiner has asked for a more descriptive title. The title has been amended in accordance with Examiner's suggestion.

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Claim Objections

The Examiner has objected to claims 12, 72, 74, 77-79, 81 and 95 because:

- a. claims 12 and 81 recite non-elected inventions.
- b. claim 72 is canceled per amendment of 12/30/2005. Examiner asked for clarification.
- c. claims 74, 77-79, 81 and 95 depend from an objected claims.

With respect to (a) Applicant notes that this is a species election and other non-elected species may be rejoined if SEQ ID NO: 121 is found patentable.

With respect to (b) Applicant thanks the Examiner for finding the typo in the amendment filed on 12/30/2005. Attached amended claim sheet.

With respect to (c), in view of the above, it is respectfully requested that claim objections will be withdrawn.

Amendments To The Claims

35 U.S.C. § 101 Rejections

The Examiner rejected claims 1, 12, 72, 74, 77-79, 81 and 95 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The claims read on a product that is not isolated or synthesized.

Examiner's rejection is respectfully traversed. Claim 74 has been cancelled without prejudice. Claims 1, 12 and 72 have been amended without prejudice, such that the claimed peptide is "synthetic" or "recombinant", to thereby distinct it from a product of nature. Support for the amendment can be found in page 21 lines 3-5.

Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 112 Rejections-Second Paragraph

The Examiner rejected claims 1, 12, 72, 74, 77-79, 81 and 95 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

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Specifically, with respect to claim 72, the Examiner states that it is not clear what the peptide includes.

While traversing Examiner's rejection, Applicant has elected to amend claim 72 such that it is now dependent on non-rejected claim 1, thereby rendering moot the rejection in this case.

With respect to claims 1 and 72, the Examiner states that it is not clear what the term "a peptide" encompasses. While traversing Examiner's rejection, Applicant has elected to amend claims 1 and 72 to relate to synthetic or recombinant peptides thereby rendering moot the rejection in this case.

35 U.S.C. § 112 Rejections-First Paragraph Enablement

The Examiner rejected claims 72, 74, 77-79, 81, 95 and 97 under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for using the claimed synthetic peptides, for the inhibition of amyloid fibril formation in the presence of IAPP in vitro, does not reasonably provide enablement for a pharmaceutical composition comprising the claimed peptide for use in the treatment or prevention of any amyloid associated disease in vivo.

While traversing Examiner's rejection, Applicant has elected to cancel claims 74 and 97 and to amend claim 72 so as to exclude the use of the peptides in the treatment of any amyloid associated disease, thereby rendering moot Examiner's rejection in this case.

In view of the above-claim amendment it is respectfully requested to remove the rejection under 35 U.S.C. § 112, first paragraph.

Double Patenting

The Examiner states that claims 1, 12, 72, 74, 77-79, 95 and 97 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-4 and 9-10 of co-pending Application number 11/471,657 June 2006.

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35 U.S.C. § 102 Rejections

The Examiner rejected claims 1, 72, 74, 77-79 under 35 U.S.C. § 102(b) as anticipated by Pispisa et al. Biopolymers 53:169-181, 2000.

The Examiner states that Pispisa et al. teach a linear Aib-based hexapeptide which comprises "Trp-Aib", thus meeting the requirements of claims 1, 72, 74, 77-79.

While traversing Examiner's rejection Applicant has elected to amend claims 1 and 72 to recite "dipeptide consisting of the amino acid sequence X-Y or Y-X, wherein X is an aromatic amino acid and Y is a beta-breaker amino acid", which is clearly not anticipated by the art of Pispisa et al. Withdrawal of the rejection is respectfully requested.

Statement

The content of the paper and computer readable form are the same and include no new matter.

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Amendments To The Drawings

Sequence identifiers have been added to Figures 1, 3a, 3c, 8a, 8b, 10b, 11, 16a, 16b, 19a, 20a, 23, 42c, 46a and 46b to overcome the drawing objection.

In view of the above amendments and remarks it is respectfully submitted that claims 1, 12, 72, 77-79, 81, 95, 163 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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Date: April 13, 2009

Enclosures:

- Petition for Extension (One Month)
- Additional Claims Transmittal Fee
- Terminal Disclaimer
- Replacement Sequence Listing
- Letter to Chief Draftsman
- Annotated Drawing Sheets
- Formal Drawing Transmittal Sheet
- Complete Set of Replacement Drawing Sheets